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EXAMINER

NGUYEN, CHAU T

ART UNIT PAPER NUMBER

2176

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/523,639

Applicant(s)

CHAKRABARTI ET AL.

Examiner

Chau Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Response to Office Action, received on 07/29/2004, has been entered. Claims 1-7 and 9-16 are presented for examination.

Response To Affidavit under 37 C.F.R. 1.131

2. The Affidavit filed on 07/29/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the effective filing date of US Patent No. 6,493,702 "System and Method for Searching and Recommending Documents in a Collection using Share Bookmarks", which was filed on May 5, 1999 by Adar et al., for at least the following reasons.
3. On page 3 of the Affidavit, Kevin S. McCurley, one of co-inventors, signed the Affidavit or Declaration under 37 C.F.R. 1.131. The Affidavit must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. In re Carlson, 79 F.2d 900, 27 USPQ 400 (CCPA 1935).
4. Assuming all of the inventors signed the Affidavit, the submitted evidence is still insufficient because of the followings:

a) On page 3 of the Affidavit, the first paragraph stated "an applet coexists with the browser, tracking the current page", which opposed claim 1 claimed "Web server for generating a table of inlinks to at least one Web page associated with the Web server".

b) Offering evidence in pages 5-6 is insufficient because it does not show the invention exists and works for its intended purpose.

5. In view of the lack of presented exhibits of support as explained above, it is the examiner's opinion that the presented affidavit is insufficient proof that Applicant's invention was conceived and reduced to practice before the filing date of the Adar et al. reference, and there is no satisfactory evidence that applicants' invention actually existed and worked for its intended purpose before the filing date of said reference.

6. Accordingly, the Affidavit filed on 05/24/2004 by Kevin S. McCurley is ineffective to overcome the effective filing date of Adar et al. reference at the present time (see also MPEP 8th Edition, section 715.07).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 7, 9-10, 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adar et al. (Adar), US Patent No. 6,493,702, and further in view of Jammes et al. (Jammes), US Patent No. 6,484,149.

9. As to claims 1, 7, 13, and 15-16, Adar discloses a computer system, comprising:
at least one user computer (col. 10, lines 8-53 and Figs. 9-10);
a data input device associated with the user computer (col. 10, lines 1-53);
a Web server communicating with the user computer (col. 5, line 38 – col. 4, line 19);

server logic means at the Web server for generating a table of inlinks to at least on Web page associated with the Web server (col. 5, line 58 – col. 6, line 19, col. 7, lines 1-19, and col. 10, lines 8-53: bookmark server in database 120 tracks availability and newness for each bookmark in the background and creates a list of bookmarks 212 (table of inlinks), and each bookmark or a link is linked to a website)

user logic means at the user computer for accessing the table of inlinks (col. 10, lines 8-53: the browser at the user's system received bookmark list from the bookmark server);

However, Adar does not explicitly disclose generating a list of sibling links based on the table, each sibling link being an outlink of one of the inlinks in the table, for accessing the sibling links. Jammes discloses a list of links includes several hyperlinks such as "automotive", "computer", and "clothing", and when a user selects a hyperlink, for example "automotive" hyperlink, html text file according to "automotive" link is interpreted by the Web browser to generate a Web page that contains three hyperlinks (sibling links or outlinks), and the user can also continue to access any one of these three hyperlinks (sibling links) (co. 45, line 17 – col. 47, line 67 and Figs. 17, 18 and 19). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jammes and Adar to include generating a list of sibling links based on the table, each sibling link being an outlink of one of the inlinks in the table, for accessing the sibling links. Jammes suggests that organizing web pages presented to each customer is customized according to recorded shopping or searching habits of the particular consumer to make the on-line shopping/searching experience more convenient and expedient as well as more pleasant.

10. As to claims 2 and 9, Adar and Jammes (Adar-Jammes) disclose wherein the user logic means includes means for downloading the table from the Web server to the user computer (Adar, Fig. 10)

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11. As to claims 3, 10, and 14, Adar-Jammes disclose wherein the user logic means includes: means for downloading the table from the Web server to the user computer (Adar, Fig. 10 and col. 10, line 8 – col. 11, line 16); and

means for automatically accessing the inlinks to search the inlinks for predetermined information (Adar, col. 8, lines 25-40 and Figs. 4 and 10).

12. As to claim 4, Adar-Jammes disclose a data storage device for storing at least portions of the table (Adar, Fig. 10 and col. 10, line 8 – col. 11, line 16).

13. Claims 5-6 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adar et al. (Adar), US Patent No. 6,493,702, Jammes et al. (Jammes), US Patent No. 6,484,149, and further in view of Khan, US Patent No. 6,546,393.

14. As to claims 5 and 11, Adar-Jammes disclose the limitations as discussed in claims 1-4, 7, 9-10, 13-16 above. However, Adar-Jammes do not explicitly disclose means at the Web server for pruning inlinks in the table in response to at least one preselected criterium. Khan discloses bookmarks (table of inlinks) may be displayed on each page by a default of approximately 250 bookmarks, or a user can change the number of bookmarks that want displayed on each page by setting user options (col. 15, lines 13-22). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Khan and Adar-Jammes to

include pruning inlinks in the table in response to at least one preselected criterium to allow users unlimited bookmarks and to present them more efficiently.

15. As to claims 6 and 12, Adar-Jammes and Khan disclose wherein the preselected criterium is based at least in part on a number of selections of each inlink (Khan, col. 15, lines 13-22: for allowing users unlimited bookmarks and to present them more efficiently).

Response to Arguments

In response to Office Action, Applicant(s) argued in substance that:

A) “contrary to the allegations in the rejections there is no reason to combine Adar et al. with Jammes et al. (USPN 6,484,149) under 35 U.S.C. § 103 because Adar et al. teaches only “bookmarks” and Jammes et al. teaches constructing hyperlinks at a web server.”

As to point A, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one

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of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Adar et al. disclose in col. 5, line 58 – col. 6, line 19, col. 7, lines 1-19, and col. 10, lines 8-53: bookmark server in database 120 tracks availability and newness for each bookmark in the background and creates a list of bookmarks 212 (table of inlinks), and each bookmark or a link is linked to a website. Adar et al. also disclose in col. 10, lines 8-53: the browser at the user's system received bookmark list from the bookmark server.

However, Adar does not explicitly disclose generating a list of sibling links based on the table, each sibling link being an outlink of one of the inlinks in the table, for accessing the sibling links. Jammes discloses a list of links includes several hyperlinks such as "automotive", "computer", and "clothing", and when a user selects a hyperlink, for example "automotive" hyperlink, html text file according to "automotive" link is interpreted by the Web browser to generate a Web page that contains three hyperlinks (sibling links or outlinks), and the user can also continue to access any one of these three hyperlinks (sibling links) (co. 45, line 17 – col. 47, line 67 and Figs. 17, 18 and 19). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jammes and Adar to include generating a list of sibling links based on the table, each sibling link being an outlink of one of the inlinks in the table, for accessing the sibling links. Jammes suggests that

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organizing web pages presented to each customer is customized according to recorded shopping or searching habits of the particular consumer to make the on-line shopping/searching experience more convenient and expedient as well as more pleasant.

16. Applicant's arguments filed 07/29/2004 have been fully considered but they are not persuasive. Please see response to Affidavit and arguments above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The examiner can normally be reached on 8:00 am – 5:00 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen
Patent Examiner
Art Unit 2176


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER